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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

10/14/01

PATENT OFFICE
SAMUEL GUTHRIE & STEWART LLP
125 FRANKLIN STREET SUITE 3000
BOSTON MA 02110

ART UNIT	PAPER NUMBER
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1725
DATE MAILED:

06/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/399,405

Applicant(s)
TORTI ET AL

Examiner
Joseph Drodge

Art Unit
1723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Publication WO 98/05427 in view of Moh et al patent 6,214,250.

Publication '427 discloses test tube 1 having sidewall 2, open top 20, concave inner surface 3 or 13 (figures 2A and 2B) , planar bottom exterior surface 6 or 17, with a single layer of machine readable data containing layer deposited thereupon (9 or 19). The data code is disclosed as being opaque and applied by laser ablating procedures (page 8, lines 25-35 and page 10, lines 30-35).

The claims differ in requiring the data code to be applied as a 2 layer coating that is deposited upon the lower planar exterior surface. However, Moh et al teach such two layer data code containing deposits applied to the exterior of a wide range of substrate products including glassy products, bottles and other small apparatus (see particularly column 2, line 28-column 3, line 17 and column 5, lines 42-61). Although language "opaque" is not explicitly recited in Moh et al, numerous coating layer materials which are inherently opaque are taught in column 8, lines 52-57. At the time the present invention was made, it would have been obvious to one of ordinary skill in this art to have modified the '427 apparatus by applying a two layer, data code containing, coating to the bottom exterior surface of the test tube rather than the disclosed one layer coating, as taught by Moh et al, in order to develop a code that can be modified and augmented repeatedly during production of and the service life of the test tube, and without damage to the substrate of the test tube itself.

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Specifically regarding claim 3, '427 teaches first cylindrical segment 3, second larger diameter segment 4 or 5 and intermediate short length of truncated conical segment therebetween as shown in figure 2A.

Regarding claims 7, 8, 12 and 13, although "hot stamping" per se. is not disclosed, Moh et al disclose various methods of applying heat and pressure to the layers during lamination to each other and to the substrate (column 16, lines 1-14, etc.)

Regarding claims 2, 4 and 5, Moh et al teach black and white layers in column 7, lines 12-53.

Regarding claims 6, 9-11, 14, 15, 17, 20 and 21, Moh et al teach a plurality of laser and other techniques of removing material to form the data code including laser ablating, abrading and etching.


Regarding claim 16, 18 and 19, Moh et al teach applying of multiple code patterns, one or more of which may be human readable and/or alphanumeric (column 3, lines 5-15).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph W. Drodge whose telephone number is (703) 308-0403. The examiner can normally be reached on Monday-Friday from approximately 8:30 AM - 4:45 PM.

The fax phone number for this Group is (703) 305-3599. When filing a FAX in Tech Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Joseph W. Drodge
Primary Examiner
Art Unit 1723

JWD
June 14, 2001